

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Clark et al.	Group Art Unit: 3771
Application No: 10/627,591	Examiner: Douglas, Steven O
Confirmation No: 2973	Attorney Docket No: 53229-US-CNT[2] (NK.0029.10)
Filed: July 25, 2003	October 14, 2009
Title: AEROSOLIZED ACTIVE AGENT DELIVERY	San Francisco, California

**REPLY BRIEF**

**VIA ELECTRONIC FILING**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Examiner:

In response to the Examiner's Answer mailed on August 14, 2009, the Applicant of the above-referenced patent application (hereinafter Appellant) hereby maintains the appeal to the Board of Patent Appeals and Interferences. Appellant requests the reversal of the Final Rejection.

**Certificate of Transmission**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, facsimile transmitted to the U.S. Patent and Trademark Office at (571) 273-8300, or electronically submitted via EFS on the date shown below:

By: Melanie Hitchcock  
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Date: October 14, 2009

***Status of Claims***

Claims 23-52 are presently pending in the case. Claims 1-22 have been cancelled. Claims 25 and 27 have been withdrawn from consideration until such time as they depend from an indicated allowable generic claim. Claims 23, 24, 26 and 28-52 have been finally rejected. The rejection of each of claims 23, 24, 26 and 28-52 is hereby appealed.

***Grounds of Rejection to be Reviewed on Appeal***

Appellant continues to request review of the Examiner's following grounds of rejection:

Claims 23, 24, 26 and 28-52 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 5,735,263 to Rubsam en et al (hereinafter Rubsam en et al).

## **Argument**

Appellant believes each of claims 23, 24, 26 and 28-52 is improperly rejected and is therefore allowable for the reasons set forth in Appellant's Appeal Brief filed on May 13, 2009. The present Reply Brief is being filed to specifically address some of the issues raised by the Examiner in the Examiner's Answer mailed on August 14, 2009. The comments herein are merely supplemental to the arguments made in the Appeal Brief and are not meant to replace those arguments.

### The rejections under §102(b) are improper

Rubsamen et al does not anticipate the independent claims in that the independent claims positively sets forth elements that are not disclosed by Rubsamens et al, as described in detail in the Appeal Brief.

For example, independent claim 23 positively recites a device comprising a flow restrictor for limiting the inspiratory flow of an aerosolized active agent formulation to a human patient to less than 17 liters per minute. This positively recited feature is not disclosed by Rubsamens et al. Rubsamens et al discloses no flow restrictor for limiting the inspiratory flow of an aerosolized active agent.

The position taken by the Examiner with regard to Rubsamens et al meeting this limitation is improper. In the Examiner's Answer, the Examiner states: "[t]he Rubsamens et al. device operates at a flow rate well within the claimed range (i.e. Examiner acknowledges that the Rubsamens et al. device operates at flow rates exceeding the claimed range, but Examiner reiterates that the device is still capable of operating at flow rates within the claimed range.)." The Examiner is improperly ignoring the positively recited limitation of the restrictor and is considering the claim to be merely limited to a range. That is not the case.

By way of making a point by analogy, consider a claim to a car that comprises a governor for limiting the car to speeds of less than 50 miles per hour. By the Examiner's reasoning, any car capable of traveling at speeds less than 50 miles per hour would satisfy the limitation, even if the allegedly anticipatory car had no governor and was capable of speeds greater than 50 miles per hour. Clearly, such position is not consistent with well established law concerning anticipation. The Examiner's position is not only without legal basis, it is fundamentally unfair to Appellant as Appellant has attempted to limit the claims in a manner that distinguishes the prior art.

The other independent claims recite similar limitations and are likewise improperly and unfairly rejected.

For this and the additional reasons discussed in the Appeal Brief, Appellant continues to requests reversal of the rejection of claims 23, 24, 26 and 28-52.

## Conclusion

Thus, it is believed that all rejections made by the Examiner have been addressed and overcome by the above arguments and the arguments provided in the Appeal Brief. Therefore, all pending claims are allowable. A reversal is respectfully requested.

Should there be any questions, Appellant's representative may be reached at the number listed below.

Respectfully submitted,

JANAH & ASSOCIATES

Dated: October 14, 2009

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